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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,618	08/07/2001	Fumitake Yodo		1741
7590	01/30/2004		EXAMINER	
Jay H. Maioli Cooper & Dunham 1185 Avenue of the Americas New York, NY 10036			FISCHER, ANDREW J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/923,618	YODO, FUMITAKE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Andrew J. Fischer	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 November 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 11 and 12 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 11 and 12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. 09/600,509.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination (“RCE”) under 37 C.F.R. §1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection (Paper No. 13). Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action (Paper No. 13) has been withdrawn pursuant to 37 C.F.R. §1.114. Applicant's submission filed on October 16, 2002 (Paper No. 14) has been entered.

### ***Acknowledgements***

2. In accordance with the RCE noted above, the after final submission has been entered. Accordingly, claims 11 and 12 remain pending.
3. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and other word processing issues. The Examiner sincerely apologizes for these errors.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example, in claim 11, Applicant now recites “A data processing

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method in an accounting system including an accounting center and a terminal device *communicating with the accounting center . . . [Emphasis added.]*" However Applicant has now amended claim 11 to recite "without communicating with the account center . . ." The body of claim 11 contradicts the preamble making the scope of the claim unclear. This same line of reasoning applies to claim 12 equally as well.

6. Because claims 11 and 12 are indefinite under 35 U.S.C. §112 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. See e.g. *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) ("Because the claims are indefinite, the claims, by definition, cannot be construed."). However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 11 and 12, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Peterson et. al. (U.S. 5,857,020)(“Peterson ‘020”). Peterson ‘020 discloses in the alternative embodiment shown in figure 3: a terminal device (86, 98 and 70 all shown in figure 3); storing accounting points in a first memory (at 91); storing distributed information (76,

80-85, 78, 79, 93, and 92) distributed from an external source (inherent) and attributes corresponding to the distributed information (initially the content is unavailable); updating the accounting points storing in the first memory of the terminal device and updating attributes (the various attributes 76, 80-85, 78, 79, 93, and 92) of the distributed information (making the encrypted information available) when the attributes is stored (e.g. when an ID is added to list 92 making the encrypted content available); when the distributed information is stored (when medium 70 is burned, the secured data 79 is in an unavailable state); when the accounting points (the funds) are updated correctly (decremented) based upon the distributed information (the requested access), the secured content is updated to an available state; carrying out account processing in the accounting center (16) based upon the accounting points transmitted from the terminal device (adding more funds to the secured card 88 through the online access to the authorization center, column 2, ~lines 62-66); when the accounting points are not updated correctly (when the system detects that the user doesn't have enough funds); a request is made at the terminal device to the accounting center for purchasing the accounting points (through the online access to the authorization center, column 2, ~lines 62-66); carrying out another account processing (providing a monthly bill to the consumer showing funds added and funds used).

9. Evidence to support the inherent features in Peterson >020 includes "online authorization process" as found column 3, ~ lines 2 and 3; the "commercial options" as found column 3, ~ lines 42-45; and the "automatic online process" as found column 9, ~ lines 52-54.

10. Regarding first and second memory locations, it is the Examiner's position that these are inherent in any computation device. Different memory addresses sufficient to hold all the claimed data disclose these limitations.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 11 and 12, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson '020.<sup>1</sup> It is the Examiner's principle position that the claims are anticipated because of the inherent features as noted above. However if not inherent, it is now admitted prior art that commercial service providers provide customers with detailed billing statements that includes at least: the name and address of the customer; previous or carry-over balances including either monies (e.g. dollars) overpaid or monies underpaid; credits received (e.g. discounts, settlements); services charged; taxes charged is old and well known in the art.

It therefore would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peterson '020 to include these features. Such a modification would have helped track billing errors allowing exact monies and services to be tracked.

13. Since Applicant did not seasonably traverse the Official Notice statement(s) as stated in the previous Office Action (Paper No. 13, Paragraph No. 7), the Official Notice statement(s) are taken to be admitted prior art. See MPEP §2144.03.

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<sup>1</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

14. The Examiner maintains his position that Applicant has decided not to be his own lexicographer. See Paper No. 13, Paragraph No. 8.

15. The Examiner maintains his position that for ex parte examination, the Examiner interprets the claims with the definitions and/or statements as noted in the previous Office Actions. See e.g. Paper No. 13, Paragraph No. 9 (a)-(h).

16. The Examiner maintains his position regarding functional language as noted in the previous Office Action, Paper No. 13, Paragraph No. 10.

17. It is the Examiner's factual determination that all limitations in claims 11 and 12 have been considered and are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)). The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

### ***Response to Arguments***

18. Applicant's arguments filed with his amendment on October 16, 2003 (Paper No. 14) have been fully considered but they are not persuasive.

19. Applicant argues that "Peterson '020 fails to show or suggest making the distributed information after processing the accounting points stored in the memory of the terminal device without communicating with the accounting center."<sup>2</sup> The Examiner respectfully disagrees.

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<sup>2</sup> Applicant's Remarks, Paper No. 14, Page 5.

20. First, this statement is contrary to the preamble making the scope of the claim unclear. Even so, the processing of the points in Peterson '020 occurs at the terminal. The terminal communicates with the accounting center to *update* the accounting points (*i.e.* add more funds). Once updated, the terminal checks to see if sufficient funds are available and only then unlocks the distributed information. Contrary to Applicant's statement, Peterson '020 does not teach receiving the authorization only from the accounting center. As stated above, the terminal does the actual processing to determine if sufficient funds or accounting points are present. For these reasons, Applicant's arguments are not persuasive.

21. Applicant's remaining arguments have been considered but also not persuasive.

### ***Conclusion***

22. The following references are pertinent to Applicant's disclosure: Hunter et. al. (U.S. 6,647,417).

23. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

24. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and

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thanks Applicant for his "Remarks" (Paper No. 14 beginning on page 5) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>3</sup> the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.

A handwritten signature in black ink that reads "AJ Fischer 3627 1/26/07". The signature is fluid and cursive, with "AJ Fischer" being the main name and "3627 1/26/07" appearing to be a date or identifier written below it.

Andrew J. Fischer  
Patent Examiner  
Art Unit 3627

AJF  
January 26, 2004

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<sup>3</sup> E.g., if the Examiner rejected a claim under '103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.